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PATENT APPLICATION
Attorney Docket No. A0041-US-NP

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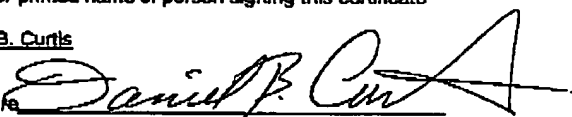
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Application of: Carl H. Hauser

Art Unit: 2154

Serial No.: 09/472,762

Examiner: Kenny S. Lin

Filed: 12/27/1999

Confirmation No: 9175

Title: PERSONAL DOCUMENT MANAGEMENT SYSTEM

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Before The Board Of Patent Appeals And Interferences Reply Brief

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

1st Named Inventor: Carl H. Hauser

Assignee: XEROX Corporation

Title: PERSONAL DOCUMENT MANAGEMENT SYSTEM

Serial No.: 09/472,762

Filed: 12/27/1999

Examiner: Lin, Kenny S.

Art Unit: 2154

Docket: 99477-US-NP

Confirmation: 9175

Mail Stop Appeal Brief - Patents

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BEFORE THE BOARD OF PATENT APPEALS AND

INTERFERENCES

REPLY BRIEF

Sir:

Appellant respectfully submits this Reply Brief to the Board of Patent Appeals and Interferences in responsive to the EXAMINER'S ANSWER mailed 3/6/2006 to support an appeal (as per Appellant's Appeal Brief) from the rejections in the Final Office Action dated June 9, 2005 in the above-referenced patent application. The two month time for reply ends on 5/6/06 that falls on a Saturday. This Reply Brief was filed on Monday, 5/8/06 and is thus timely filed per 37 CFR 1.7(a). Appellant requests that the Appeal be maintained.

Application No. 09/472,762
Technology Center 2100 – Art Unit 2154

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STATUS OF CLAIMS

Claims 1 - 18 are pending in this application, of which claims 1, 3, 5 and 7 are independent claims. Claims 1 – 18 stand rejected. The Claims Appendix, following the Argument, provides the text of the appealed claims.

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GROUND OF REJECTION TO BE REVIEWED ON APPEAL

- I. Whether claims 1, 3, 5, 9 – 10, 13 and 16 are anticipated under 35 U.S.C. § 102(b) by the disclosure of U.S. Patent 5,721,910 issued to Unger et al.
- II. Whether claims 7, 11, 14 and 17 are patentable under 35 U.S.C. § 103(a) over the disclosure of U.S. Patent 5,721,910 issued to Unger et al. in view of Official Notice.
- III. Whether claims 2, 4, 6 and 8 are patentable under 35 U.S.C. § 103(a) over the disclosure of U.S. Patent 5,721,910 issued to Unger et al. in view of the disclosure of U.S. Patent 5,071,419 issued to MacPhail.
- IV. Whether claims 12, 15 and 18 are patentable under 35 U.S.C. § 103(a) over the disclosure of U.S. Patent 5,721,910 issued to Unger et al. in view of the disclosure of U.S. Patent 6,418,457 issued to Schmidt et al.

The Final Office Action (dated 6/09/05) also included a rejection of independent claim 7 under 35 U.S.C. § 112 because the term “personal documents” in line 14 (referenced as line 16 in the Final Office Action) of the claim lacks proper antecedent basis. Appellant is not appealing this rejection. In a Reply to a previous Office Action submitted in January 2005, appellant amended all of the claims to replace the term “personal document” with “stored document.” Appellant intended to make the same change to all occurrences of “personal document” in claim 7 but inadvertently overlooked the term “personal document” in line 14 and the change was not made. If the decision of this appeal results in allowable subject matter or further prosecution on the merits, claim 7 will be corrected to replace the term “personal documents” with “stored documents.”

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ARGUMENT**I. The Final Office Action fails to state a prima facie case of anticipation under 35 U.S.C. § 102(b) with respect to claims 1, 3, 5, 9 – 10, 13 and 16.**

Re: in reply to argument (I): In Appellant's Appeal Brief, appellant agreed that Unger teaches the element of "determining the document category of the loaded document" at Unger col. 3, lines 9-15. Appellant pointed out that the "predetermined search strategies" in the cited text are the expert technical searches (ETS) generated from a hierarchical model. The ETS are used to populate the database with categorized documents (by searching for "documents that are pertinent to each individual category with the Customized Technical Subject Hierarchy..." (Unger, col. 5, lines 57-59). Appellant pointed out in the first paragraph of page 12 of the Appeal Brief, that because Unger teaches the element of determining the document category of the loaded document using ETS "that the Examiner now must show where Unger teaches the extracting and applying steps".

Further, the language of claim 1 requires that the applying step must follow both the determining and extracting steps. Thus, the Examiner must provide a showing of teachings in Unger that disclose the applying step and all of its limitations occurring after the database in Unger is populated by the ETS.

Appellant points out that Unger's Stage I – Stage III are used to gather the documents, to analyze the documents and store the analysis results, and to extract information from the documents to yield normalized data (Unger, col. 5, lines 3-35). Stage IV is a Technical Subject Hierarchy that includes levels containing sets of categories relevant to that level of the Hierarchy. These sets of categories define the concepts being modeled (Unger, col. 5, lines 36-51).

The Hierarchy is then used to generate expert searches (ETS/pre-defined search protocols) to identify documents that are pertinent to each individual category in the Hierarchy (Unger, col. 5, lines 51-60). Thus, the execution of the expert searches automatically categorizes the documents within the Hierarchy.

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The identification of Unger col. 3, lines 9-15 as teaching the step of “determining the document category of the loaded document” teaches that the possible document categories are already known (those categories in the Hierarchy used to generate the ETS) but that the document-category association is not known until after the ETS is applied. Thus, the documents are not categorized until after the ETS is applied.

The Examiner’s Answer asserts that “appellant’s allege that the determining step must be preceding[sic] the extracting and applying step because the applying step uses data generated from the determining and extracting step is only...”. However, the actual sentence from the Appeal Brief is “While the language of claim 1 does not dictate a temporal order on the determining and extracting steps, the applying step must follow these two steps because the applying step uses data generated from the determining and extracting steps.” Thus, appellant has made no assertion as to the temporal order of the determining and extracting step other than to assert that both of these steps must occur prior to the applying step. Appellant has respectfully recast the Examiner’s statement below to be that consistent with the appellant’s assertion as stated in the Appeal Brief.

The Examiner’s Answer asserts that the rational for requiring the applying step to follow the determining and extracting steps is “...only true if the document does not already have a defined document category”. Then the Examiner’s Answer provides examples of documents from Stage I – Stage III as being examples of documents having a pre-defined category. However, as previously discussed, the determining of the document-category association is not known until after the ETS is applied. Thus, how Stage I – Stage III documents are categorized within the set of categories (of the Hierarchy) is not known until after the ETS is applied. Thus, the rational supporting the Examiner’s Answer is faulty because the documents cannot have a defined category prior to application of the ETS. Thus, the step of determining must occur prior to the step of applying.

Re: in reply to argument (2): The Examiner’s Answer continues to evaluate the appellant’s arguments using the faulty assertion that the documents can have a defined category prior to application of the ETS. The Examiner’s Answer then continues to

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address appellant's issues using the faulty assertion instead of explaining how the citations in Unger teach the claimed limitations.

Regarding the assertion that since "the appellants fail to define the functionality of 'document handling procedure' in the claims, appellant's argument that col. 3 lines 22-25 of Unger does not teach 'the document handling procedure is associated with the category determined in the earlier determining step' is incorrect." --- the appellant reminds the Examiner that the claims are given their broadest reasonable interpretation in light of the specification as read by one skilled in the art. The instant application discusses document handling procedures at least at the text starting on page 6, line 15 through page 7, line 12. Thus, appellant respectfully traverses the implication that the functionality of the document handling procedure must be defined in the claim. Furthermore, the functionality of the document handling procedure is defined in the claim by "said document handling procedure linking said loaded document to at least one of said plurality of stored documents using the at least one of the document date, the document transaction type and the document identifier extracted from said loaded document".

Appellant respectfully traverses all assertions in the Examiner's Answer that are related to an open-ended definition of "document handling procedure".

II. The Final Office Action fails to state a prima facie case of obviousness under 35 U.S.C. § 103(a) with respect to claims 7, 11, 14 and 17.

Re: in reply to argument (3): The Examiner's Answer continues to evaluate the appellant's arguments using the faulty assertion that the documents can have a defined category prior to application of the ETS. The Examiner's Answer then continues to address appellant's issues using the faulty assertion instead of explaining how the citations in Unger teach the claimed limitations.

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Appellant again submits that Unger teaches away from the manual assignment of the document category to the document by the use of the expert technical searches which automatically categorize the documents in the database taught in Unger. Nothing in Unger teaches or suggests the possibility of manually assigning a document to a category within the Hierarchy because the categorization of the documents was automatically performed responsive to the application of the ETS.

III. The Final Office Action fails to state a prima facie case of obviousness under 35 U.S.C. § 103(a) with respect to claims 2, 4 and 6.

Re: in reply to argument (4): Appellant respectfully traverses the reasoning provided in the Examiner's Answer justifying the 103(a) rejection to claims 2, 4 and 6. Appellant reasserts the reasoning provided in the Appeal Brief. Nothing in Unger teaches or suggests a document handling procedure that includes retention criteria for determining how long to save the loaded document as is taught in the instant application at page 8, lines 9-22. The arguments provided in the Examiner's Answer are not persuasive. While database maintenance is a common practice, Unger requires that the loaded documents are kept so that the model can be used to access known technology. While true that documents can be incorrectly entered, or there may be other mistakes that need to be corrected, once the correct document is input into Unger, it is retained and not subject to a retention criteria (that of deleting the document after some period of time). If the loaded document is deleted in accordance with a retention policy after some period of time, the knowledge contained in that document is lost and vanishes from Unger's invention.

IV. The Final Office Action fails to state a prima facie case of obviousness under 35 U.S.C. § 103(a) with respect to claims 12, 15 and 18.

Re: in reply to argument (5): Appellant respectfully traverses the reasoning provided in the Examiner's Answer justifying the 103(a) rejection to claim 12, 15 and 18 and reasserts the arguments provided in the Appeal Brief.

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In view of the discussion and arguments presented above, Appellant respectfully submits that claims 1 – 18 are patentably distinguishable over the references cited in the rejections in the Final Office Action, and are in condition for allowance. Appellant requests that the rejections to claims 1 – 18 be withdrawn and the application be passed to issue.

Respectfully submitted,

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CLAIMS APPENDIX

There exist no new issues or changes in this section; Appellant therefore incorporates the Claims Appendix of *Appellant's Appeal Brief* herein by reference.

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EVIDENCE APPENDIX

None.

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RELATED PROCEEDINGS APPENDIX

None.

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